

REMARKS

The applicants have studied the Final Office Action dated November 25, 2003, and respectfully request entry of this amendment under the provisions of 37 CFR § 1.116(a) in that the amendments above and remarks below place the application and claims in condition for allowance and in better form for consideration on appeal. By virtue of this amendment, claims 1 and 34 are requested to be amended; thus, claims 1-5, 7-19, 34, 36, 39, 40, 59, and 60 are pending. Consideration and allowance of all the pending claims in view of the above amendments and the following remarks are respectfully requested.

Claims 1-5, 7-18, 34, 36, 40, and 60 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kakimi et al. Claims 39 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakimi et al. These rejections are respectfully traversed.

Amended claim 1, and claims 2-5, 7-18, 39, and 40 depending therefrom, recite a piston including a “first member having an external proximate side and an external distal side, the external proximate side being adapted to contact the fluid and being made of a material having a first stiffness, and wherein the external distal side forms an opening leading to a cavity and includes threads adapted to releasably engage the threaded linear actuation member” (emphasis added). Amended claim 34, and claims 36, 59, and 60 depending therefrom, recite similar language. The Kakimi et al. reference fails to disclose, teach, or suggest a piston including a first member with an external distal side that has threads adapted to releasably engage a threaded linear actuation member, as recited in the claims.

The Kakimi et al. reference is directed to a medical syringe. The syringe 2 includes a syringe body 3 and a plunger 4 fitted in the syringe body 3. The Examiner asserts that the plunger 4 comprises an elastic cover 9 (first member) and a plunger body component 8 (second member). The Examiner further asserts that the elastic cover 9 is adapted to releasably engage a linear actuation member by means of plunger body components 6 and 7. Although the plunger 4 may be connected to a linear actuation member, such as piston 13, the elastic cover 9 (first member) does not include any threads adapted for releasably engaging a threaded linear actuation

member, as recited in the claims. Thus, the Kakimi et al. reference does not disclose, teach, or suggest a piston including a first member with an external distal side that has threads adapted to releasably engage a threaded linear actuation member, as recited in claims 1-5, 7-18, 34, 36, 39, 40, 59, and 60.

Accordingly, withdrawal of the rejections of claims 1-5, 7-18, 34, 36, 39, 40, 59, and 60 under 35 U.S.C. §§ 102(e) and 103(a) is respectfully requested.

Finally, the applicants continue to acknowledge the election of Group I, Species D shown in Figs. 19-20b, as defined by claims 1-5, 7-19, 34, 36, 39, 40, 59, and 60. However, the applicants note that the Examiner did not respond to applicants' arguments regarding inclusion of the species shown in Figs. 21(a)-22(b), 24(a)-24(b), 27(a)-27(b), and 29(a)-29(b) in the election.

For the reasons presented in the applicants' previous Amendment dated August 25, 2003, the applicants submit that the species shown in Figs. 21(a)-22(b), 24(a)-24(b), 27(a)-27(b), and 29(a)-29(b) are not patentably distinct from the species shown in Figs. 19-20(b). Further, the applicants submit that elected claims 1 and 34 are generic to the embodiments shown in Figs. 19-22(b), 24(a)-24(b), 27(a)-27(b), and 29(a)-29(b). Accordingly, inclusion of these species in the election and consideration by the Examiner are respectfully requested. All the pending claims are directed to elected species, and thus, the application includes no nonelected claims to be canceled.

The applicants respectfully submit that the foregoing amendments and remarks place the application and the claims in condition for allowance, and in better form for consideration on appeal, and thus, may be admitted under 37 CFR § 1.116(b). With respect to those amendments deemed to touch the merits, admission is requested under 37 CFR § 1.116(c). In this connection, the amendments were not earlier presented because they are in response to matters pointed out for the first time in the Final Office Action.

In view of the foregoing, it is respectfully submitted that the application and all of the claims are in condition for allowance. Entry of the foregoing amendments, and reexamination and reconsideration of the application as amended, are respectfully requested.

If, for any reason, the Examiner finds that the application is other than in condition for allowance and believes that a telephone interview would advance the prosecution of the application, the Examiner is invited to call the undersigned attorney at (818) 576-5291.

Respectfully submitted,

Date: February 25, 2004

By: 
Vivian S. Shin
Reg. No. 43,919

MEDTRONIC MINIMED, INC.
18000 Devonshire Street
Northridge, CA 91325
Telephone: (818) 576-5291
Facsimile: (818) 576-6202